

Applicants: David M. Stern, et al.
U.S. Serial No.: 08/905,709
Filed: August 5, 1997
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REMARKS

Claims 1-4, 8, 9, 15-18, 36-39 and 46 are pending in the subject application. Claims 38 and 39 have been cancelled. Claim 1 has been amended. Support for this amendment may be found *inter alia* in the specification of priority application 08/592,070 ('070 application) at page 11, lines 3-5, page 13, lines 30-35, Table 1, page 29, lines 22-26, page 29, lines 32-34 and page 30, lines 1-5. Applicants maintain that the amendment of claim 1 raises no issue of new matter and is fully supported by the specification of the '070 application as filed. Applicants respectfully request that this Amendment be entered. Upon entry of this Amendment, claims 1-4, 8, 9, 15-18, 36, 37 and 46 will still be pending and under examination.

It is noted that claims 5, 10, 12, 13, 19-27, 29, 30 and 32-35 were cancelled in the Amendment in Response to June 29, 2001 Office Action, filed on December 28, 2001, without prejudice or disclaimer to applicants' right to pursue the subject matter of those claims in a later filed application.

Claim of Priority

The Examiner asserts that the subject matter defined in claims 1-5, 8-10, 12, 13, 15-27, 29, 30, 32-39 and 46 has an effective filing date of August 5, 1997, which is the filing date of the subject application. The '070 application, filed on January 26, 1996 and the 08/755,235 application filed on November 22, 1996, allegedly fail to provide adequate support under 35 U.S.C. §112 for the

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instantly claimed invention.

In response to the Examiner's position with respect to claims 5, 10, 12, 13, 19-27, 29, 30, 32-35, 38 and 39, but without conceding the correctness thereof, applicants point out that these claims have been canceled, thereby rendering the Examiner's position moot.

Further, applicants respectfully traverse the Examiner's position regarding applicants' claim of priority with respect to claims 1-4, 8, 9, 15-18, 36, 37 and 46.

Claims 1-4, 8, 9, 15-18, 36, 37 and 46, as amended, provide a method of inhibiting atherosclerosis in a subject suffering from hyperlipidemia which comprises administering to the subject a polypeptide comprising the extracellular domain of soluble receptor for advanced glycation endproduct (sRAGE) or a derivative thereof capable of inhibiting an interaction between *amyloid- β peptide* and receptor for advanced glycation endproduct (RAGE) in an amount effective to inhibit atherosclerosis in the subject.

The Examiner, on page 4 of the Office Action, concedes that the '070 application discloses a method for treating a subject with hyperlipidemic atherosclerosis by administering an agent capable of inhibiting the interaction of amyloid- β peptide with RAGE. The Examiner, on page 5, further concedes that the '070 application discloses the use of sRAGE as the agent in the method and the RAGE NH2-terminal sequence. This NH2-terminal sequence in turn corresponds to the extracellular domain of RAGE. See page 29, lines 32-34 and page 30, lines 1-5 of the '070 specification.

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Accordingly, applicants maintain that the '070 Application provides adequate support under 35 U.S.C. §112 for the subject matter of claims 1-4, 8, 9, 15-18, 36, 37 and 46, as amended. As a result, the subject matter of claims 1-4, 8, 9, 15-18, 36, 37 and 46, is entitled to an effective filing date of January 26, 1996, which is the filing date of the '070 application.

Rejection Under 35 U.S.C. §102(e)

The Examiner rejected claims 1-5, 8-10, 12, 13, 15-27, 29, 30, 32-39 and 46 under 35 U.S.C. 102(e) as allegedly anticipated by U.S. Patent No. 5,864,018 ("Morser").

In response to the Examiner's rejection of claims 5, 10, 12, 13, 19-27, 29, 30, 32-35, 38, 39 but without conceding the correctness thereof, applicants point out that these claims have been canceled, thereby rendering the rejection thereof moot.

Further, applicants respectfully traverse the rejection of claims 1-4, 8, 9, 15-18, 36, 37 and 46.

A rejection based on 35 U.S.C. §102(e) can be overcome by perfecting priority under 35 U.S.C. §120 by amending the specification of the application to contain a specific reference to a prior application. Applicants contend that the claimed invention is entitled to a priority date of January 26, 1996 as discussed above. Therefore, since Morser is only available as a reference as of August 16, 1996, i.e. after the January 26, 1996 effective filing date of the claimed invention, Morser is not available as a §102(e) reference.

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In view of the above remarks, applicants maintain that claims 1-4, 8, 9, 15-18, 36, 37 and 46 satisfy the requirements of 35 U.S.C. §102(e).

Rejection under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 38 and 39 under 35 U.S.C. §112, second paragraph, as allegedly indefinite. Specifically, the Examiner asserted that there is insufficient antecedent basis for the limitation "the agent" in the claims.

In response to the Examiner's rejection, but without conceding the correctness thereof, applicants point out that claims 38 and 39 have been canceled, thereby rendering the rejection moot.

Claim Objections

The Examiner objected to claims 10, 13, 27 and 30 under 37 C.F.R. §1.75(c), as allegedly being of improper dependent form for failing to further limit the subject matter of claim 1.

In response to the Examiner's objection, but without conceding the correctness thereof, applicants point out that claims 10, 13, 27 and 30 have been canceled, thereby rendering the objection moot.

The Examiner objected to claims 1 and 19 because they recite the terms "sRAGE," "AGE" and "RAGE", which should all be spelled out in each independent claim for clarity.

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In response to the Examiner's objection to claim 19, but without conceding the correctness thereof, applicants point out that claim 19 has been canceled, thereby rendering the objection moot.

In response to the Examiner's objection to claim 1, but without conceding the correctness thereof, applicants point out that amended claim 1 spells out the phrases for which "sRAGE" and "RAGE" stand.

In view of the above remarks, applicants maintain that claim 1 satisfies the requirements of 35 U.S.C. §112, second paragraph.

Summary


For the reasons set forth hereinabove, applicants respectfully request that all the claims of this application be allowed, and that the application proceed to issuance.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.


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No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


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